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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,720	11/13/2003	Yonichi Tei	FUJI:281	2196

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ROSSI & ASSOCIATES
P.O. Box 826
Ashburn, VA 20146-0826

EXAMINER

RESAN, STEVAN A

ART UNIT PAPER NUMBER

1773

DATE MAILED: 09/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,720

Applicant(s)

TEI ET AL.

Examiner

Stevan A. Resan

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6-22 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031113.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for disk shaped substrates, does not reasonably provide enablement for all substrates of any shape. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to obtain the benefits of the invention commensurate in scope with these claims.

There is no teaching of the injection molding of substrates other than disk substrates. Shapes other than a disk present problems of injection molding of a disk with the desired surface roughness and flatness which are not addressed in the specification and which could not be determined except by an undue burden of experimentation by one of ordinary skill in the art.

Furthermore, in order to obtain the benefits of the invention (T_g and thermal stability required) specific structure polymers with specific cyclization rates are required which are not present in the independent claims (See specification [0026]-[0029].

4. Claim 1, 2, 4, 6, 7, 9-12, 14, 15, 17-19, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1,2 and 20 contain the term "type".

The word "type" renders the claim indefinite because the addition of the word type to an otherwise definite expression extends the scope of the expression so as to render it indefinite. See MPEP § 2173.05(b).Ex parte Copenhaver, 109 USPQ 118 (Bd. App. 1955).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 6-9, 11-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over the state of the art at the time of the invention as admitted and shown by the references of record. See specification [001]-[0012]; Hirata et al US 6,333,089 Col 4 lines 44-65, Col 10 lines 7-45

Injection molded disk substrates are old in the magnetic recording art. In order to deposit a magnetic layer on the disk and to write and reproduce data to and from the magnetic layer the dimensional stability of the magnetic layer and substrate must be high. As recording density increases this becomes more acute. It would have been obvious to one of ordinary skill in the art to select a high Tg polymer with high thermal stability to address these problems such was done by selecting a polycarbonate or norborene polymer. One of ordinary skill in the art could select from a wide variety of high Tg, high thermally stable polymers including those of claims 1-3 (See Butler- J.

Polymer Science). Substitution of equivalents requires no express motivation as long as the prior art recognizes the equivalency.

In re Fount 213 USPQ 532 (CCPA 1982); In re Siebentritt 152 USPQ 618 (CCPA 1967); Graver Tank & Mfg. Co. Inc. v. Linde Air Products Co. 85 USPQ 328 (USSC 1950).

Finding the members of a class of prior art polymers (in this case high Tg highly thermally stable) that are best suited for a particular purpose is not a patentable invention. Ex parte Fauser (POBA 1953) 128 USPQ 156.


7. Claims 4, 5 and 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The allowability of these claims is based upon the showing of unexpected superior results compared with polycarbonate and norborene resins and their commensurateness with the showing.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stevan A. Resan whose telephone number is 571-272-1513. The examiner can normally be reached on Tues-Thurs from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached at 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


STEVAN A. RESAN
PRIMARY EXAMINER